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KEATING & BENNETT LLP

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Fax

To: Mr. Paul Shanoski**From:** Christopher A. Bennett

Office of Petitions

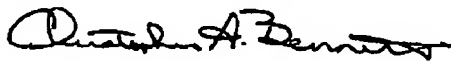
Fax: 703-872-9306**Date:** August 31, 2004**Phone:** 703-305-0011**Pages:** 13**Re:** Renewed Petition under 37 C.F.R. §
1.53(e)**CC:****•Comments:**

Dear Mr. Shanoski,

Please find the following documents for the above-identified application:

1. Renewed Petition under 37 C.F.R. § 1.53(e);
2. a copy of the Petition under 37 C.F.R. § 1.53(e) filed on July 7, 2004;
3. a copy of the Notice of Omitted Parts mailed on July 1, 2004;
4. a copy of the stamped returned postcard acknowledging receipt of the application;
5. a copy of Fig. 3 as originally filed; and
6. a copy of the Decision on Petition filed on August 23, 2004.

Respectfully submitted,




Christopher A. Bennett
Reg. No. 46,710

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AUG 31 2004

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being transmitted to Mr. Paul Shanoski,
Office of Petitions, 703-872-9306, addressed to: U.S. Patent and Trademark Office,
P.O. Box 1450, Alexandria, VA 22313-1450.

Date: August 31, 2004


Christopher A. Bennett

PATENT
36856.1172

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Jun ENDO and Teruyoshi MUKAIHIRA Serial No.: 10/728,464 Filing Date: December 5, 2003 For: POINTING DEVICE AND METHOD OF PRODUCING THE SAME	Art Unit: 2673 Examiner: Not yet assigned
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RENEWED PETITION UNDER 37 C.F.R. 1.53(e)

Attention: Paul Shanoski
c/o Office of Petitions
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Mr. Shanoski:

On July 7, 2004, Applicants submitted a Petition under 37 C.F.R. § 1.53(e) (copy enclosed) to respond to a Notice of Omitted Items mailed on July 1, 2004 which indicated that Figure 3 described in the originally filed specification appeared to have been omitted from the application filed with the U.S. Patent and Trademark Office ("USPTO") on December 5, 2003.

In support of Applicants' Petition under 37 C.F.R. § 1.53(e), Applicants submitted a copy of the returned postcard (copy enclosed) which indicated that 7 sheets of

Serial No.: 10/728,464
August 31, 2004
Page 2 of 2

drawings were submitted and received by the USPTO, along with a copy of Figure 3 (copy enclosed) as filed with the USPTO on December 5, 2003.

Applicants received a Decision on Petition (copy enclosed), dated August 23, 2004, which indicated that the Petition was dismissed because "the electronic file contains 7 pages of drawings, containing Figures 1-2, 5-7, and two copies of Figure 4. Figure 3 has not been located in the electronic file. . . . Since the postcard indicates that 7 pages of drawings were included on filing, and 7 pages of drawings were indeed located in the electronic file, it appears that each of the seven pages which were submitted made their way into the electronic file. Unfortunately, figure 3 does not appear to be among these pages. The PTO file is the official record of all papers filed in this application. A review of the official file reveals that Figure 3 was not received on filing. Instead, a duplicate copy of Figure 4 appears to have been filed in its stead. . . . As such, it appears that Figure 3 was not filed with the Office on December 5, 2003. For this reason, the petition cannot be granted."

Applicants have carefully reviewed their copy of this application as filed, and hereby assert that Figure 3 was deposited in the USPTO with the application papers filed on December 5, 2003 and that Applicants did not file a duplicate copy of Figure 4 as alleged by the USPTO.

Accordingly, Applicants respectfully request that the original paper copy of the application as filed on December 5, 2003 be reviewed by the USPTO to confirm that Figure 3 was deposited in the USPTO with the application papers filed on December 5, 2003, that Applicants did NOT file a duplicate copy of Figure 4 instead of a copy of Fig.

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August 31, 2004
Page 3 of 3

3, and that the duplicate copy of Figure 4 in the electronic file of this application is the result of an error on the part of the USPTO made by the USPTO during the scanning and image capture procedures performed by the Office of Initial Patent Examination of the U.S. Patent Office.

For the foregoing reasons, Applicants respectfully request that the present Petition be granted.

A general authorization/petition for extensions of time and required fee was filed concurrently with the filing of the present application. The Commissioner of Patents is authorized to charge any shortage in the fees due or credit any overpayment to Deposit Account No. 50-1353.

Respectfully submitted,

Date: August 31, 2004



Attorney for Applicant(s)
Christopher A. Bennett
Registration No. 46,710

KEATING & BENNETT, LLP
10400 Eaton Place
Suite 312
Fairfax, VA 22313
Telephone: (703)385-5200

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Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to the: Mail Stop Missing Parts, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Date: July 7, 2004

Sonia V. McVean
Sonia V. McVean

PATENT
36856.1172

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Jun ENDO and Teruyoshi MUKAIHIRA Serial No.: 10/728,464 Filing Date: December 5, 2003 For: POINTING DEVICE AND METHOD OF PRODUCING THE SAME	Art Unit: 2673 Examiner: Not yet assigned
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PETITION UNDER 37 C.F.R. 1.53(e)

Mail Stop Missing Parts
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Notice Of Omitted Item(s) in a Nonprovisional Application
Filed Under 37 C.F.R. 1.53(b), mailed July 1, 2004, enclosed please find the following:

1. Copy of the Notice Of Omitted Items;
2. Check in the amount of \$130.00 to cover the petition fee under 37 C.F.R.
1.17(i);
3. Copy of the returned postcard with evidence of receipt from the PTO; and
4. Figure 3, apparently, missing from the application.

Serial No.: 10/728,464
July 7, 2004
Page 2 of 2

Applicants hereby assert that figure 3 was deposited in the PTO with the application papers filed December 5, 2003. Because the postcard receipt itemizes 7 sheets of formal drawings and is stamped by the PTO as being received, the postcard serves as *prima facie* evidence of receipt of figure 3 in the PTO, as set forth in MPEP §503. A substitute figure 3 is submitted herewith in the event that figure 3 deposited with the application is not found.

A general authorization/petition for extensions of fee was filed concurrently with the filing of the present application. The Commissioner of Patents is authorized to charge any shortage in the fees due or credit any overpayment to Deposit Account No. 50-1353.

Respectfully submitted,



Attorney for Applicant(s)
Joseph R. Keating
Reg. No. 37,368

Date: July 7, 2004

KEATING & BENNETT, LLP
10400 Eaton Place
Suite 312
Fairfax, VA 22313
(703)385-5200

Serial No. UNKNOWN. MUST CALL Attorney: CAB TRK Mailing Date 12/05/2003
Client AKA 10 Our Ref. No. 36856. 1172
Title POINTING DEVICE AND METHOD OF...
Applicant(s): AKA ENDO JAO
The following, due 01/20/2004 in the U.S. Patent & Trademark Office, was received in
the U.S. Patent & Trademark Office Mail Room on the date stamped hereon:

<input checked="" type="checkbox"/> Patent Application, Including:	<input type="checkbox"/> Amendment
<input checked="" type="checkbox"/> 26 Pages of Specification, including:	<input type="checkbox"/> Request for Reconsideration
<input checked="" type="checkbox"/> 20 Claims and Abstract	<input type="checkbox"/> Amendment After Final Rejection
<input checked="" type="checkbox"/> Drawings <u>2</u> Sheet(s) (FORMAL)	<input type="checkbox"/> Response to Restriction Requirement
<input checked="" type="checkbox"/> Combined Decl./Power of Atty.	<input type="checkbox"/> Notice of Appeal
<input checked="" type="checkbox"/> Transmittal Letter	<input type="checkbox"/> Letter to Official Draftsperson
<input type="checkbox"/> Associate Power of Attorney	<input type="checkbox"/> Issue Fee Transmittal
<input checked="" type="checkbox"/> Assignment with PTO 1595	<input type="checkbox"/> Change of Address
<input type="checkbox"/> Small Entity Status Form	<input type="checkbox"/> Response to NTFMP
<input checked="" type="checkbox"/> Priority Document(s) (4)	<input checked="" type="checkbox"/> General Authorization to Charge Acct.
<input type="checkbox"/> Petition for Extension of Time	<input type="checkbox"/> Charge Acct. Authorization for \$
<input type="checkbox"/> Preliminary Amendment	<input checked="" type="checkbox"/> Credit Card Payment Form for \$ <u>330.00</u>
<input checked="" type="checkbox"/> IDS w/ Form PTO 1449 w/	<input checked="" type="checkbox"/> Credit Card Payment Form for \$ <u>40.00</u>
<u>2</u> cited references	<input type="checkbox"/> Check No. _____ for \$ _____
<input type="checkbox"/> Request for Continued Examination	<input type="checkbox"/> Check No. _____ for \$ _____
<input type="checkbox"/> Request for App. of Drwg. Corrections	
<input type="checkbox"/> VIA HAND DELIVERY	
<input type="checkbox"/> CERTIFICATE OF MAILING	
<input checked="" type="checkbox"/> EXPRESS MAIL NUMBER: <u>EL629609046US</u>	

22278 U.S. PTO
10/728464
120503



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COMMISSIONER FOR PATENTS
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Paper No. None

Keating & Bennett LLP
Suite 312
10400 Eaton Place
Fairfax VA 22030

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AUG 23 2004

OFFICE OF PETITIONS

In re Application of
Jun Endo et al.
Application No. 10/728,464
Filing Date: December 5, 2003
Attorney Docket No. 36856.1172
Title: POINTING DEVICE AND METHOD
OF PRODUCING THE SAME

DECISION ON PETITION

BACKGROUND

This is a decision on the petition filed July 9, 2004, requesting that the above-identified application be accorded a filing date of December 5, 2003, with Figure 3 as part of the original disclosure of the application.

The application was deposited December 5, 2003. However, on July 1, 2004, the Office of Initial Patent Examination (OIPE) mailed a notice stating that the application had been accorded a filing date of December 5, 2003, and that the application appeared to have been deposited without Figure 3.

With the instant petition, Petitioner has submitted a copy of Figure 3 along with the petition fee. Petitioner has asserted that Figure 3 was included on filing. In order to support this allegation, Petitioner has included a copy of his postcard receipt acknowledging receipt of "drawings 7 sheets (formal)" in the United States Patent and Trademark Office (Office) on December 5, 2003.

THE RELEVANT SECTION OF THE MPEP

Section 503 of the MPEP, entitled Application Number and Filing Receipt, sets forth, in part:

RETURN POSTCARD

Application No. 10/728,464

Page 2

If a receipt of any item (e.g., paper or fee) filed in the USPTO is desired, it may be obtained by enclosing with the paper a self-addressed postcard specifically identifying the item. The USPTO will stamp the receipt date on the postcard and place it in the outgoing mail. A postcard receipt which itemizes and properly identifies the items which are being filed serves as prima facie evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO.

The identifying data on the postcard should be so complete as to clearly identify the item for which receipt is requested. For example, the postcard should identify the applicant's name, application number (if known), confirmation number (if known), filing date, interference number, title of the invention, etc. The postcard should also identify the type of paper being filed, e.g., new application, affidavit, amendment, notice of appeal, appeal brief, drawings, fees, motions, supplemental oath or declaration, petition, etc., and the number of pages being submitted. If a new application is being filed, all parts of the application being submitted should be separately listed on the postcard, e.g., the number of pages of specification (including written description, claims and abstract), number of claims, number of sheets of drawings, number of pages of oath/declaration, number of pages of cover sheet (provisional application).

The postcard receipt will not serve as prima facie evidence of receipt of any item which is not adequately itemized on the postcard. For example, merely listing on the postcard "a complete application" or "patent application" will not serve as a proper receipt for each of the required components of an application (e.g., specification (including claims), drawings (if necessary), oath or declaration and the application filing fee) or missing portions (e.g., pages, sheets of drawings) of an application if one of the components or portion of a component is found to be missing by the USPTO. Each separate component should be specifically and properly itemized on the postcard. Furthermore, merely incorporating by reference in the postcard receipt, the items listed in a transmittal letter will not serve as prima facie evidence of receipt of those items.

The person receiving the item(s) in the USPTO will check the listing on the postcard against the item(s) being filed to be sure they are properly identified and that all the items listed on the postcard are presently being submitted to the USPTO. If any of the items listed on the postcard are not being submitted to the USPTO, those items will be crossed off and the postcard initialed by the person receiving the items.

Upon return of a postcard receipt from the USPTO, the postcard receipt should be promptly reviewed by the person who filed the items to ensure that every item specifically denoted on the postcard was received by the USPTO. If the postcard receipt has been annotated to indicate that a particular item denoted on the postcard was not received by the USPTO, the postcard receipt will not serve as prima facie evidence of receipt of that item in the USPTO.

ANALYSIS

It is noted that the electronic file contains 7 pages of drawings, containing Figures 1-2, 5-7, and two copies of Figure 4. Figure 3 has not been located in the electronic file.

Obviously, the degree on which applicants may rely on a postcard receipt to establish receipt of a particular item depends on the specificity of the itemization. Since the postcard indicates that 7 pages of drawings were included on filing, and 7 pages of drawings were indeed located in the electronic file, it appears that each of the seven pages which were submitted made their way into the electronic file. Unfortunately, figure 3 does not appear to be among these pages.

The PTO file is the official record of all papers filed in this application. A review of the official file reveals that Figure 3 was not received on filing. Instead, a duplicate copy of Figure 4 appears to have been filed in its stead. An applicant alleging that a paper was filed in the Office and later misplaced has the burden of proving the allegation by a preponderance of the evidence. Petitioner's assertion that figure 3 was included on filing is not more persuasive than either the electronic file or the postcard receipt which he prepared and submitted.

As such, it appears that Figure 3 was not filed with the Office on December 5, 2003. For this reason, the petition cannot be granted.

Application No. 10/728,464

Page 3

CONCLUSION

For these reasons, the petition is **DISMISSED**.

The petition fee of \$130.00 will not be refunded, as this petition was not necessitated by any error on the part of the Office.

The application file is being returned to OIPE for further processing with a filing date of December 5, 2003, using only the application papers which were filed on that date. Figure 3 will not be entered.

If petitioner desires for the examiner to consider this page which was not submitted as part of the original disclosure, then petitioner may submit this figure via an amendment. Any such amendment will, of course, be reviewed by the examiner for new matter¹. The amendment is not new matter if the substance was a part of the disclosure of the prior application.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (703) 305-0011. Please note that on approximately September 28, 2004, the Office of Petitions will relocate to the new PTO location in Alexandria. Although the mailing address will remain the same, the general phone number for the Office of Petitions which should be used for status requests will change to 571-272-3282, and the telephone number for the undersigned will change to 571-272-3225.



Paul Shanowski
Senior Attorney
Office of Petitions
United States Patent and Trademark Office

¹ See MPEP 608.02(h) and 608.04.



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NUMBER	FILING OR 371 (c) DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NUMBER
10/728,464	12/05/2003	Jun Endo	36856.1172

Keating & Bennett LLP
Suite 312
10400 Eaton Place
Fairfax, VA 22030

CONFIRMATION NO. 2192

FORMALITIES LETTER



OC000000013119768

Date Mailed: 07/01/2004

NOTICE OF OMITTED ITEM(S) IN A NONPROVISIONAL APPLICATION

FILED UNDER 37 CFR 1.53(b)

A filing date has been accorded to the above-identified nonprovisional application papers; however, the following item(s) appear to have been omitted from the application:

- Figure(s) 3 described in the specification.

I. Should applicant contend that the above-noted omitted item(s) was in fact deposited in the U.S. Patent and Trademark Office (USPTO) with the nonprovisional application papers, a copy of this Notice and a petition (and \$130.00 petition fee (37 CFR 1.17(h))) with evidence of such deposit must be filed within **TWO MONTHS** of the date of this Notice. The petition fee will be refunded if it is determined that the item(s) was received by the USPTO.

II. Should applicant desire to supply the omitted item(s) and accept the date that such omitted item(s) was filed in the USPTO as the filing date of the above-identified application, a copy of this Notice, the omitted item(s) (with a supplemental oath or declaration in compliance with 37 CFR 1.63 and 1.64 referring to such item(s)), and a petition under 37 CFR 1.182 (with the \$130.00 petition fee (37 CFR 1.17(h))) requesting the later filing date must be filed within **TWO MONTHS** of the date of this Notice.

Applicant is advised that generally the filing fee required for an application is the filing fee in effect on the filing date accorded the application and that payment of the requisite basic filing fee on a date later than the filing date of the application requires payment of a surcharge (37 CFR 1.16(e)). To avoid processing delays and payment of a surcharge, applicant should submit any balance due for the requisite filing fee based on the later filing date being requested when submitting the omitted item(s) and the petition (and petition fee) requesting the later filing date.

III. The failure to file a petition (and petition fee) under the above options (I) or (II) within **TWO MONTHS** of the date of this Notice (37 CFR 1.181(f)) will be treated as a constructive acceptance by the applicant of the application as deposited in the USPTO. **THIS TWO MONTH PERIOD IS NOT EXTENDABLE UNDER 37 CFR 1.136(a) or (b).** In the absence of a timely filed petition in reply to this Notice, the application will maintain a filing date as of the date of deposit of the application papers in the USPTO, and original application papers (i.e., the original disclosure of the invention) will include only those application papers present in the USPTO on the date of deposit.

In the event that applicant elects not to take action pursuant to options (I) or (II) above (thereby constructively electing option (III)), amendment of the specification to renumber the pages consecutively and cancel incomplete sentences caused by any omitted page(s), and/or amendment of the specification to cancel all references to any omitted drawing(s), relabel the drawing figures to be numbered consecutively (if necessary), and correct the

references in the specification to the drawing figures to correspond with any relabeled drawing figures, is required. A copy of the drawing figures showing the proposed changes in red ink should accompany with any drawing changes. Such amendment and/or correction to the drawing figures, if necessary, should be by way of preliminary amendment submitted prior to the first Office action to avoid delays in the prosecution of the application.

Replies should be mailed to: Mail Stop Missing Parts
Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

A copy of this notice MUST be returned with the reply.

me
Customer Service Center
Initial Patent Examination Division (703) 308-1202

PART 2 - COPY TO BE RETURNED WITH RESPONSE